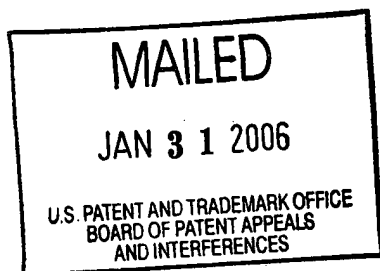


The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte KURT CLEMENT

Appeal No. 2006-0174
Application No. 09/518,787

ON BRIEF

Before: THOMAS, BARRETT and NAPPI, **Administrative Patent Judges.**
NAPPI, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 1 through 29. For the reasons stated *infra* we reverse the examiner's rejection of these claims.

Invention

The invention relates to a method of distributing software with a computer system. The software is recorded on a fixed media within the computer prior to transfer of the computer to the user. See page 6 of appellant's specification.

Upon detection of the use of the software on the computer system, a party authorized to grant access to the software is queried to determine the user's authority to access the software. If the user is authorized, the user is granted access to the software, and the authority is recorded on the computer to be used for subsequent access to the software. See page 7 of appellant's specification.

Claim 1 is representative of the invention and is reproduced below:

1. A method of distributing software with a computer system to a user comprising the acts of:
 - recording data on a fixed medium in the computer system;
 - providing for transfer of the computer system to the user; and
 - controlling access to the data in the computer system by:
 - in response to receiving a first request for access to the data, contacting a party authorized to grant access to the data;
 - if the party provides authorization to grant access to the data, recording the authorization in the computer system and granting a first access to the data based on the recorded authorization; and
 - in response to receiving at least a second request for access to the data, granting a second access to the data based on the authorization recorded in the computer system.

Reference

The reference relied upon by the examiner is:

Wyman

5,438,508

August 1, 1995

Rejection at Issue

Claims 1 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's own admission and Wyman.

Opinion

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellant and the examiner, and for the reasons stated *infra* we will not sustain the examiner's rejection of claims 1 through 29 under 35 U.S.C. § 103(a).

Appellant argues, on pages 7 and 8 of the reply brief dated October 6, 2005 (hereinafter second reply brief), that:

Independent claims 1, 10, and 21 all include the feature of recording a data access authorization *in the same computer system* in which the data is stored. In contrast, Wyman explicitly teaches recording data access authorizations (i.e., "licenses") *in a remote license server*. The Examiner has chosen to ignore this explicit teaching of Wyman, however, and instead construe the "handle" taught by Wyman as the claimed data access authorization.

On pages 8 and 9 of the second reply brief, appellant presents definitions of the term "handle" from two reference books and argues that the examiner's reliance on Wyman's teaching of using a handle cannot be equated with appellant's claimed authorization to access the data stored on the fixed media in the computer system. Further, on pages 13 through 17 of the second reply brief, appellant argues that Applicant's Admissions and Wyman do not provide the teaching or suggestion to make the claimed invention.

On page 3 of the answer the examiner takes Official notice that it was well known at the time of the appellant's invention to sell computers with software already installed on the machine's hard disk. The examiner asserts that Wyman teaches that when a program is started a check is made as to whether usage is permitted. In response to appellant's argument that Wyman does not teach storing authorization on the same computer as the data, the examiner states on page 9 of the answer:

Assuming for the sake of the current argument that the computer system in question and relied upon by the Appellant is in the form of a client machine and not a system of networked computers such as, for example, an LAN/WAN or corporate intranet, the combination of Applicant's own admissions and Wyman disclose the digital data access system, as shown above. Wyman, in at least column 23, lines 11-37, specifically teaches storing the authorization handle on the client computer for future reference, and in at least column 4, lines 38-42 and lines 46-50 discloses that it was common practice in the art at the time of the invention to maintain individual licenses and store the license privilege proofs on each client system.

We are not persuaded by the examiner's reasoning. First, we determine the scope of the claim. In analyzing the scope of the claim, office personnel must rely on appellant's disclosure to properly determine the meaning of the terms used in the claims. **Markman v. Westview Instruments, Inc.**, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir. 1995). "[I]nterpreting what is *meant* by a word in a claim 'is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.'" (emphasis original) **In re Cruciferous Sprout Litigation**, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir. 2002) (citing **Intervet America Inc. v. Kee-Vet Laboratories Inc.**, 887 F.2d 1050, 1053, 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). Claim 1 includes the limitations of "recording data on a fixed medium in the computer system", "in response to receiving a first request for access to the data, contacting a party authorized to grant access to the data; if the party provides authorization to grant access to the data, recording the authorization in the computer system" and "granting a second access to the data based on the authorization recorded in the computer system." Independent claims 10 and 21 contain similar limitations. Appellant's specification identifies on page 4, that a computer system can be "any of a number of computer systems capable of carrying out computer executable code." Thus, the scope of claim 1 includes data stored on a fixed medium of a device capable of carrying out computer executable code. The authorization received in response to a first request to access the data is

recorded in the same device as the data and is used in response to a second request to access the data.


While we concur with the examiner's findings that it was well known at the time of the invention to sell computers with software already installed, and that it was known that some software require authorization prior to use, we do not find that the examiner has presented objective evidence that it was known at the time of the invention that software installed on a computer prior to transfer to a user required authorization prior to the first use of the software and that the authorization is stored on the computer to permit a second use of the software. We find, as appellant argues, Wyman teaches that the authorization, a license, to use a software program is stored in a server. See items 10 and 14 of figure 1. Wyman teaches that the program itself is stored on the individual user devices. See item 17 figure 1. We do not find, as the examiner asserts, that Wyman's discussion of the use of handles meets the claim limitation of recording authorization on the device for a second access to the data. We find that Wyman teaches that when the use of the program is authorized a "handle" is stored for later use. See column 23, lines 26 and 27. We do not find that this later use is to authorize a second access to the program. Rather, Wyman teaches that when the execution of the program is completed, the handle is retrieved and returned to the server through a release allocation. See column 23, lines 31 through 37 and 61 through 64. Further, while we concur with the examiner's statement that Wyman in "column 4, lines 38-42 and lines 46-50 discloses that it was common

practice in the art at the time of the invention to maintain individual licenses and store the license privilege proofs on each client system," we do not find that Wyman teaches, or suggests, for programs already installed on a client's machine, in response to a first attempt to access the data, authorization is requested and recorded on the client's device, and that the authorization is later used to grant a second access to the data. Accordingly, we will not sustain the examiner's rejection of claims 1 through 29 under 35 U.S.C. § 103(a).

Conclusion

In summary, we will not sustain the examiner's rejections of claims 1 through 29 under 35 U.S.C. § 103(a). The decision of the examiner is reversed.

REVERSED


JAMES D. THOMAS
Administrative Patent Judge

Lee E. Barrett
LEE E. BARRETT
Administrative Patent Judge


ROBERT E. NAPPI
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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